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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RONALD PAUL DEAN, KRISTINA LYNN MANN,
SEAN WILLIAM TUCKER, and DAVID WILLIAM MAYER

Appeal 2008-2818
Application 10/618,275
Technology Center 3600

Decided: February 25, 2009

Before: JENNIFER D. BAHR, LINDA E. HORNER, and JOHN C. KERINS, *Administrative Patent Judges*.

BAHR, *Administrative Patent Judge*.

ORDER REMANDING TO THE EXAMINER

STATEMENT OF THE CASE

Ronald Paul Dean et al. (Appellants) appeal under 35 U.S.C. § 134 from the Examiner's Final Rejection of claims 1-16 and 21-24. Claims 17-20, the only other pending claims, have been withdrawn from consideration. We have jurisdiction over this appeal under 35 U.S.C. § 6 (2002).

In the Final Rejection, mailed July 29, 2005, the Examiner rejected claims 1-9, 12-16, 21, and 24 under the judicially created doctrine of obviousness-type double patenting; claims 1-7, 10-16, and 21-23 under 35 U.S.C. § 102(b) as being anticipated by Joss (US 5,823,495); and claims 1-4, 6-9, 12, 21, and 24 under 35 U.S.C. § 102(b) as being anticipated by Ramsdell (US 5,344,032).

In the Amended Appeal Brief, filed February 9, 2006, Appellants identified only the two rejections under 35 U.S.C. § 102(b) as issues to be reviewed on appeal. Appeal Br. 5. Appellants stated that "Appellant has proposed submitting a terminal disclaimer in compliance with 37 C.F.R. § 1.321(c) if the obviousness-type double patenting rejection of claims 1-9, 12-16, 21, and 24 … stands upon indication that the claims are allowable." *Id.* Appellants presented no arguments directed to the merits of the obviousness-type double patenting rejection. Appellants provided over thirteen pages of arguments specifically pointing out claimed features that Appellants believe are not found in Joss and Ramsdell in contesting the anticipation rejections under 35 U.S.C. § 102(b).

In the first Examiner's Answer ("2006 Answer"), mailed May 4, 2006, the Examiner pointed out Appellants' proposal to submit a terminal disclaimer (2006 Answer 3) and repeated the anticipation rejections under 35 U.S.C. § 102(b), without articulating any explanation or rationale for the

rejections (2006 Answer 4). Purportedly in response to Appellants' arguments, the Examiner merely stated that all of the limitations of the rejected claims are found in Joss and in Ramsdell. 2006 Answer 4.

In the Reply Brief filed June 30, 2006, Appellants urged that the Examiner had failed to comply with the provisions of MPEP § 1207.02(A)(9)(e) and objected to the Examiner's failure to respond to any of the arguments presented in the Appeal Brief (Reply Br. 2-3), and reiterated some of those arguments (Reply Br. 3).

In an "ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER" ("Order"), mailed March 19, 2007, the Examiner was ordered to (a) issue a revised Examiner's Answer listing the prior art of record and any other evidence relied upon in the rejections and (b) reconsider the Reply Brief in light of Appellants' assertion that the Examiner has not complied with MPEP § 1207.02(A)(9)(e), and respond accordingly. Order 2.

In response to that Order, the Examiner issued a revised Answer ("2007 Answer"), mailed July 24, 2007. The Examiner once again pointed out Appellant's proposal to submit a terminal disclaimer (2007 Answer 3) and repeated the anticipation rejections under 35 U.S.C. § 102(b) (2007 Answer 4). In the section entitled "(10) Response to Argument," the Examiner articulated a detailed rationale for the anticipation rejection based on Joss and for the anticipation rejection based on Ramsdell. The Examiner's rationale for the rejection based on Ramsdell articulated on pages 7 and 8 of the 2007 Answer differs in certain substantive respects from that articulated on pages 5-7 of the Final Rejection, so as to effectively change the thrust of the rejection. Merely by way of example, on page 7 of the 2007 Answer, the Examiner read the deforming element of claim 1 on a

member or part of core 18 of Ramsdell, the resiliently-deformable surface of claim 1 on the cover 19 of Ramsdell, and the pair of attachment members of claim 1 on the liner 20 of Ramsdell. This is in contrast to the Examiner's reading of the deforming element and pair of attachment members on the liner 20 and cover 19, respectively, of Ramsdell on page 5 of the Final Rejection. Likewise, in reading claim 2 on Ramsdell on page 7 of the 2007 Answer, the Examiner found that grooves 26 of Ramsdell's liner 20 correspond to the claimed fastener sites. This is in contrast to the Examiner's reading of the claimed fastener sites on Ramsdell's core 18 on page 6 of the Final Rejection. Although the differences are more minor in nature, the stated rationale for the anticipation rejection based on Joss in the 2007 Answer also differs in several respects from that in the Final Rejection. For example, in addressing claim 4 on page 5 of the 2007 Answer, the Examiner read the serpentine metal strip on planar surface 104 or spring 118 of Joss, rather than on the middle section 120 of the spring 118 of Joss, as stated on page 4 of the Final Rejection. In addressing claim 15 on page 6 of the 2007 Answer, the Examiner read the claimed opposing outer lateral portions of said surface on rear end 105, rear receiving portions 108, and cammed roll-in features 109 of Joss, rather than on rear receiving portions 108, cammed roll-in features 109, or middle section 120 of Joss, as stated on page 5 of the Final Rejection.

The rationale for the anticipation rejection based on Ramsdell articulated in the 2007 Answer so changes the thrust of the rejection set forth in the Final Rejection as to effectively constitute a new ground of rejection. *See In re Kronig*, 539 F.2d 1300, 1302-03 (CCPA 1976) (The criterion for whether a rejection is a new ground of rejection is whether the applicant has

had fair opportunity to react to the thrust of the rejection.) However, the Examiner did not identify the rejection as a new ground of rejection in the 2007 Answer, much less identify it "prominently" as such, as set forth in MPEP § 1207.03. Nor did the 2007 Answer provide Appellants a two-month time period for reply or include the approval of a TC Director or designee, as also required in MPEP § 1207.03.

ORDER

In light of the above, we remand this application to the Examiner pursuant to 37 C.F.R. § 41.50(a)(1) (2008)

(1) to clarify whether claims 1-9, 12-16, 21, and 24 stand rejected under the judicially created doctrine of obviousness-type double patenting and

(2) for each rejection under 35 U.S.C. § 102(b), to state clearly and unequivocally, claim element-by-claim element, how each of the claims reads on the applied prior art and, if such statement differs from that articulated in the Final Rejection so as to change the thrust of the rejection, to comply with the procedures set forth in MPEP § 1207.03 to identify the rejection as a new ground of rejection and provide Appellants with a two-month time period for reply to the new ground.

This remand to the Examiner pursuant to 37 C.F.R. § 41.50(a)(1) is made for further consideration of a rejection. Accordingly, 37 C.F.R. § 41.50(a)(2) applies if a supplemental examiner's answer is written in response to this remand by the Board.

REMANDED

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